4/17/01

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Bottorff

Opposition No. 114,000

Ariel Remos

v.

Ariel Feierman

Before Quinn, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark ARIEL, in typed form, for services recited in the application as "entertainment services, namely, live performances rendered by a musical group."[1] Opposer filed a timely notice of opposition to registration of applicant's mark, alleging that opposer is the prior user of the mark ARIEL in connection with musical entertainment services and that applicant's use of her mark in connection with her recited services is likely to cause confusion. See Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant

[1] Serial No. 75/476,262, filed April 29, 1998. In the application, applicant alleges use of the mark since January 14, 1996, and use of the mark in commerce since April 1, 1996.

filed an answer by which she denied the allegations of the notice of opposition which are essential to opposer's claim.

This case now comes up on the parties' cross-motions for summary judgment as to opposer's Section 2(d) claim. The motions have been fully briefed.[2] The evidence of record on summary judgment includes: the file of the opposed application; the pleadings; the two declarations of opposer Ariel Remos and the exhibits attached thereto; the declaration of opposer's witness Cliff Walker and the exhibits attached thereto; the declaration of applicant Ariel Feierman and the exhibits attached thereto; the declaration of applicant's witness Robert Torsello and the exhibits attached thereto; and the two declarations of applicant's counsel Lana Fleishman and the exhibits attached thereto. Applicant has objected to certain of opposer's documentary exhibits; those objections will be discussed *infra*.

We have carefully considered all of the parties' arguments and all of the evidence properly made of record, including any arguments or evidence not specifically discussed in this opinion. For the reasons discussed below, we grant opposer's motion for summary judgment and deny

[2] Applicant's objection to opposer's sur-reply brief is well-taken, and we have given that paper no consideration. See Trademark Rule 2.127(e)(1).

applicant's cross-motion for summary judgment. *See* Fed. R. Civ. P. 56(c).

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 248 (1986). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id*. When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. *See* Fed. R. Civ. P. 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.,* 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may

only determine whether a genuine issue of material fact exists. *See Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

There is no genuine issue of material fact that opposer is the owner of application Serial No. 75/477,155, by which he seeks registration of the mark ARIEL for "entertainment in the nature of a live or recorded performing musical group," or that applicant's prior-filed application has been cited against opposer's application as a potential Section 2(d) bar to registration of opposer's mark. In view thereof, we find that opposer has standing to oppose registration of applicant's mark in this proceeding. *See Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990).

We turn next to the question of priority, which is an issue in this case because opposer does not own an existing registration upon which he can rely under Section 2(d). *Distinguish, e.g., King Candy Co., Inc. v. Eunice King's*

Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To establish his priority under Section 2(d), opposer must prove that, vis-à-vis applicant, he owns "a mark or trade name previously used in the United States… and not abandoned…."

There is no dispute that the date of applicant's first use of her mark, and the earliest date upon which she can rely for purposes of priority, is January 14, 1996. Accordingly, opposer's Section 2(d) priority claim requires proof that opposer owns a mark or trade name used in the United States prior to January 14, 1996 and not abandoned.

In his first summary judgment declaration, opposer Ariel Remos avers as follows, in pertinent part:

> 1. My name is Ariel Remos and I am the leader of a four person club band called "Ariel." I sing lead vocals, play keyboard and drums and write, arrange and produce all our original songs.
>
> 2. I began to use the mark "Ariel" for the band on December 12, 1981.
>
> 3. The band originally began playing in South Florida nightclubs and in festivals throughout the southeast. We now play throughout the country, in the Caribbean and in Central America. The band has been featured on "CBS This Morning" and on the Univision and Telemundo Spanish Television Networks. I have continued to use the mark "Ariel" throughout the United States for the band since 1981. In addition, I am creating a Web site under the name "ariel-band.com" to market the band on the Internet. I currently use it and have never abandoned it.

> 4. We have recently finished our first album in both Spanish and English which will be distributed worldwide under the "Ariel" mark.
>
> 5. On January 8, 1991 I registered the trademark "Ariel" for Entertainment Services in the nature of a musical group.
>
> 6. My registration was cancelled on July 14, 1997 for failure to file a Section 8 Affidavit.
>
> 7. I applied to reregister the mark on April 30, 1998.
>
> 8. I first learned of Applicant's use of the mark "Ariel" when its application was cited against mine on February 1, 1999.

In his second summary judgment declaration, submitted with his response to applicant's cross-motion for summary judgment, opposer Ariel Remos avers as follows, in pertinent part:

> 1. My name is Ariel Remos and I am the leader of a four-person club band called "Ariel." The band's name encompasses and refers to all the members of the band. It has also become associated with the type of high energy performing we do. As the band's leader I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself.
>
> 2. In addition, the band has several booking agents who book the band and also handle advertising and promotion of the band always under the "Ariel" mark. These include Walker Entertainment, Fantasma, Deco Productions, Southern Nights, Adam Productions, and Vega (Louisiana) (See Declaration of Cliff Walker).
>
> 3. Since 1981, I estimate that we have spent approximately $5,000.00 per year on advertising and promotion of the band under the trademark "Ariel." Unfortunately, I have not saved copies

> of many of the materials that have accompanied our performances over the years or retained many old records. It has consisted in the past and now consists of yellow pages advertising, press releases and promotional flyers, distribution of business cards and correspondence on Ariel stationery.
>
> 4. Since the band was formed in 1981, the band has averaged one hundred and four (104) dates or two dates a week a year including 1995, 1996, 1997, 1998, 1999 and 2000. We play at hotels, on cruise ships, in clubs and restaurants, at Disney World, at corporate events, and at country clubs. We have performed in music festivals, on English and Spanish television, in Las Vegas, New Orleans, Nashville and San Antonio as part of a national tour for the television program "Entertainment U.S.A." in 1993. At all performances, the "Ariel" mark is prominently displayed.
>
> 5. Total sales from entertainment services have ranged from $30,000.00 to $100,000.00 a year.
>
> 6. The band is well known in Miami and the Southeast by the "Ariel" mark.
>
> 7. We have begun distributing worldwide our first CD under the "Ariel" mark.
>
> 8. Performing with the band "Ariel" has been my only job since the early 90's. It's the only work I do. It pays my rent. It supports my family. I intend to continue writing, playing and performing as long as possible.

Opposer also has submitted the declaration of Cliff Walker, who avers as follows, in pertinent part:

> 2. My company, Walker Entertainment, Inc. has represented the band Ariel since 1983 as its booker and promoter. Since that time I have booked the band in approximately two to ten venues a year from 1983 to the present. In addition, I am responsible for providing information regarding the entertainment services of the band Ariel to potential venues and engagements.

> 3. Upon request, I provide to potential venues promotional materials, flyers, and direct mails. The materials are all provided under the "Ariel" trademark.
>
> 4. I have most recently booked entertainment services under the mark "Ariel" to the Sunfest Festival held May 3-7, 2000 in West Palm Beach, Florida. The Sunfest Festival is Florida's largest music, art and waterfront festival drawing 300,000 people. The performance by the band was held under a prominently displayed "Ariel" mark.
>
> 5. I also refer potential bookings to the "ariel-band.com" Web site for information regarding the band.

We find that the averments contained in these declarations are sufficient, if unopposed, to establish that opposer has used ARIEL as a mark for his musical entertainment services since a date prior to applicant's first use of the mark in January 1996, and that opposer's use of the mark has not been abandoned.

Applicant has not presented any counter-declarations or other evidence which rebuts the factual averments made in opposer's declarations, nor has applicant identified any genuine issue of material fact with respect to those averments. Instead, applicant argues that the declarations submitted by opposer are entitled to no probative weight on the question of opposer's use and priority because they contain certain alleged internal contradictions which render the declarations untrustworthy in their entireties, and because opposer allegedly has failed to present sufficient

corroborating documentation for all of the averments made in the declarations. We disagree.

Regarding the alleged internal contradictions in the declarations, applicant first contends (at page 4 of her reply brief) that "[i]n his Second Declaration, Opposer claims that he handles the advertising and promotion for the band's performances. (Remos Second Dec. ¶ 1). Opposer then claims that booking agents are actually responsible for the band's advertising and promotional activities." However, in paragraphs 1-2 of his second declaration, opposer actually avers as follows: "As the band's leader I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself. In addition, the band has several booking agents who book the band and also handle advertising and promotion of the band always under the 'Ariel' mark." (Emphasis added.) Thus, opposer states that he handles "most of" the advertising and promotion for the band, in addition to several booking agents who "also" handle the advertising and promotion. These statements are not contradictory.[3]

[3] To arrive at her conclusion that the statements in ¶¶ 1 and 2 of opposer's second declaration are contradictory, applicant apparently construes opposer's statement (in ¶ 1 of his declaration), i.e., "I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself," such that the words "most of" modify only the words "the financial matters" and not the words "the advertising and promotion." Another valid construction, however, and one which is more likely to be correct because it allows ¶¶ 1 and 2 to be read together without contradiction, is

Likewise, and contrary to applicant's contention, there is no contradiction between opposer's statement (in ¶ 4 of his second declaration) that "the band has averaged one hundred and four (104) dates or two dates a week a year," and Mr. Walker's statement (in ¶ 2 of his declaration) that he has "booked the band in approximately two to ten venues a year." As is apparent from ¶¶ 1-2 of Mr. Remos' second declaration, Mr. Walker is not the only booking agent for opposer's band. Opposer handles some of the booking himself, and the band also engages several other booking agents in addition to Mr. Walker. Thus, the fact that Mr. Walker books opposer's band for two to ten dates per year is not inconsistent with Mr. Remos' assertion that the band plays 104 dates per year.

In short, applicant's contentions regarding the alleged internal contradictions in opposer's declarations are not borne out by the declarations themselves. We are not persuaded by applicant's argument that the declarations as a whole should be disregarded on account of the alleged contradictions.

Applicant also argues that the three declarations submitted by opposer should be disregarded in their entireties because the averments contained therein (as to the details of the nature, duration and extent of opposer's

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that the words "most of" modifies both "the financial matters"

advertising and sale of his services under his mark) are not adequately corroborated by admissible, probative documentary evidence. For the reasons discussed below, we disagree.

Among the documentary exhibits to Mr. Remos' two declarations and to Mr. Walker's declaration are photocopies of programs, invitations, tickets and advertisements pertaining to various events and functions at which performances by opposer and his band were the featured musical entertainment.[4] These documents, which were prepared and distributed by the third-party sponsors of such events and functions, include, in chronological order of performance:

> (1) invitation to the April 30, 1988 Florida Customs Brokers and Forwarders Association "Gala Installation Banquet" in Miami, Florida, which states "Music by 'Ariel'";
>
> (2) invitation to the November 17, 1990 Cuban American National Foundation "Gala Dinner Dance" in Miami, Florida, which states "Music by Ariel";
>
> (3) ticket to the February 2, 1991 "LBA" benefit event in Miami, Florida, which states "Music by: Ariel";

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and "the advertising and promotion."

[4] As discussed *infra*, we find that these third-party documents are sufficient to corroborate and establish opposer's claim of prior, non-abandoned use of his mark. Opposer has submitted various other documents as well, to which applicant has objected on various grounds. In general, we are not persuaded by applicant's objections. However, because we find that opposer's priority claim is sufficiently established by the documents discussed in the text of this opinion, we need not and do not base our decision on these other documents of opposer's, nor do we rule specifically on applicant's objections thereto.

> (4) program for the February 8, 1991 St. Thomas the Apostle "Eighth Annual Dinner Dance" in Key Biscayne, Florida, which states "Music by Ariel";
>
> (4.A) ticket to the same February 8, 1991 St. Thomas the Apostle Dinner Dance, which states "Music by: Ariel";
>
> (5) program for the March 7, 1992 Saint Patrick School "Gala Dinner Dance" (location undisclosed) which states "Music by Ariel";
>
> (6) ticket to the May 14, 1994 "Baptist Hospital Ball" in Miami, Florida, which states "Dancing to Music by Varon and Ariel";
>
> (7) invitation to the April 27, 1996 Florida Customs Brokers & Forwarders Association "Gala Installation Banquet" in Miami, Florida, which states "Music by 'Ariel'";
>
> (8) newspaper advertisement for the December 31, 1997 Doral Golf Resort and Spa "New Year's Eve Gala" in Miami, Florida, which states "Dance the Night Away with Renowned 6 pc. Band "Ariel";
>
> (9) program for the 1998 Asociacion Latinoamericana "Latin Fever Ball" in Atlanta (Buckhead), Georgia, which states "Dancing throughout the evening to the sound of Ariel"; and
>
> (10) Sunfest 2000 advertisement depicting the "Performance Schedule" for Saturday May 6, 2000, which includes a listing for a performance by "Ariel."

Applicant has not contended, nor has she presented any evidence which would suggest, that opposer and his band did not actually render musical performances at the events and functions identified in the above-referenced third-party documents. Instead, applicant asserts various evidentiary arguments against the admissibility of certain of the

documents, and various legal arguments for the proposition that none of the documents establish that opposer has any service mark or other proprietary rights in ARIEL.

We turn first to a consideration of applicant's evidentiary objections to certain of the above-referenced documents. Specifically, applicant has objected to the admissibility of the above-numbered documents (3), (4.A), (6), (7), and (9), which were attached as Exhibit Nos. 2(a)-(d) to Mr. Remos' second declaration.[5] Applicant objects to these documents under Fed. R. Evid. 403, on the ground that they are merely cumulative of the documents which were attached to the first Remos declaration and are accordingly a waste of time. The objection is overruled. These additional documents, even if cumulative, are not so numerous as to be wasteful of the parties' or the Board's time and efforts.

Applicant also objects to these documents under Fed. R. Evid. 901, on the ground that they are not properly authenticated. This objection is overruled. Applicant has not contended that these documents were manufactured or fabricated by opposer. Indeed, as applicant herself has

[5] Applicant raised no specific evidentiary objections to the admissibility of above-numbered documents (1), (2), (4), (5), (8) and (10), and any such objections to those documents are deemed waived. *See* Fed. R. Evid. 103(a). Applicant's various substantive legal arguments regarding the probative value of all of the above-referenced documents (Nos. (1)-(10)) will be discussed below.

argued, these documents were independently prepared and distributed by third parties, not by opposer. Any technical defect in the manner in which opposer introduced and authenticated these documents via his declaration is not dispositive, inasmuch as there simply exists no basis in the record for concluding that these documents are other than what they appear to be. *See* Fed. R. Evid. 901(a) and 901(b)(4).

Finally, applicant has objected to documents (3), (4.A), (6), (7), and (9) under Fed. R. Evid. 401 and 402, on the ground that they are not relevant to this action. This evidentiary objection is premised on applicant's substantive legal arguments regarding the alleged lack of probative value of all of the above-referenced third-party documents. For the reasons discussed below, we reject applicant's substantive legal arguments; we accordingly also overrule applicant's relevancy objections which are based on those arguments.

Applicant's first substantive argument is that none of the above-referenced documents are evidence of service mark use of ARIEL by opposer because they were not created or distributed by or on behalf of opposer for the purpose of advertising or promoting opposer's entertainment services to prospective purchasers of those entertainment services, i.e., to those who might engage opposer to provide musical

entertainment services. Rather, the documents are advertisements, programs, invitations and tickets which were created and distributed by the various third-party organizations and sponsors themselves, to advertise and promote their own hotel, banquet, school dance and restaurant services to their members and/or to the general public. According to applicant, the designation ARIEL, as it appears in the documents, is not used as a service mark by opposer; rather, it is used by the third parties in a merely informational sense, to identify the musical entertainment the third parties are presenting as part of their hotel, banquet, school dance and restaurant services.

We are not persuaded by this argument. Applicant cites no case law or statutory authority which supports her contention that these documents must be disregarded as evidence of opposer's use of the mark ARIEL merely because they were created and distributed by the third parties, rather than by opposer.[6] Indeed, applicant herself has submitted and relies upon numerous documents of exactly the same type as evidence of her use of her own mark. On their face, opposer's documents show that opposer was engaged by the various third parties to provide musical entertainment

[6] Applicant cites to TMEP §1304.01, which sets forth a non-exclusive list of types of documents which are acceptable as specimens in service mark applications. That section is not apposite to or dispositive of the priority dispute in this opposition proceeding.

services under the mark ARIEL at the identified events and functions. There is no basis in the record for concluding that opposer and his band did not, in fact, render musical entertainment services under the mark at those events and functions. The fact that the advertisements were prepared and distributed by third parties rather than by opposer is inconsequential.

Applicant's second substantive argument with respect to these third-party documents submitted by opposer is that the designation ARIEL is used in these documents solely to identify opposer personally, and not as a service mark for opposer's entertainment services. We disagree. The newspaper advertisement for the Doral New Year's Eve Gala (document no. (8) above) specifically refers to the "Renowned 6 pc. Band 'Ariel.'" Likewise, there is no reasonable basis in the record for inferring that the other documents, when they use the designation ARIEL, are referring to opposer personally, rather than to the band.

In summary, we find that the above-referenced documents establish that opposer and his band were engaged to render, and did render, live musical performances under the mark ARIEL in 1988, 1990, 1991, 1992, 1994, 1996, 1997, 1998 and 2000. We find that the averments in opposer's summary judgment declarations regarding opposer's prior use and non-

abandonment of the mark have been corroborated, at least to that extent.[7] Taken together, the documents and the declaration averments are sufficient to establish opposer's Section 2(d) priority in this case.

Applicant makes two other arguments with respect to the priority issue which require comment. First, applicant has cited various authorities in support of the proposition that personal name marks, such as opposer's, are merely descriptive and not entitled to protection absent a showing of secondary meaning. However, applicant has not cited to any prior decisions of the Board or of its primary reviewing court in which this proposition has been stated or followed, and we are aware of no such decisions. For the reasons discussed below, we are not persuaded that we should follow the authorities cited by applicant on this issue.

A personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be inherently distinctive under the Lanham Act. Indeed, applicant's own mark ARIEL, which is also applicant's personal name, was not refused registration as merely

[7] It is not dispositive that opposer's documents do not corroborate each and every detailed averment made in opposer's declarations, i.e., as to the specific dollar amounts of opposer's sales and advertising, or as to the geographic scope of opposer's use of the mark. Opposer need not substantiate each of those specific averments in order to establish his Section 2(d) priority, vis-à-vis applicant.

descriptive, and was forwarded to publication by the Office without any requirement for a showing of acquired distinctiveness. We see no logical basis for holding that a personal name mark which is inherently distinctive for registration purposes must nonetheless be shown to have acquired secondary meaning before it can be relied upon by an opposer in an opposition proceeding. Thus, we reject applicant's argument regarding opposer's alleged failure to establish secondary meaning in his mark.

Applicant also argues that she is entitled to an "adverse inference," and to dismissal of the opposition, due to opposer's alleged failure, despite the pendency of this proceeding, to retain discoverable documents. Applicant cites *Supreme Oil Co. v. Lico Brands, Inc.*, 39 USPQ2d 1695 (TTAB 1996) in support of this argument. However, *Supreme Oil Co.* involved a fully-briefed motion for discovery sanctions under Fed. R. Civ. P. 37. No such motion was filed by applicant in this case; rather, the request for an adverse inference was raised by applicant for the first time in her reply brief. Opposer has had no opportunity to respond on the merits of applicant's request. In view thereof, we deny applicant's request for an unspecified "adverse inference" and her request for dismissal based thereon.

Having found that opposer has established his priority for purposes of Section 2(d), we turn now to the issue of likelihood of confusion. Our likelihood of confusion determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the respective marks and the similarities or relatedness of the respective goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

There is no genuine issue of material fact that applicant's mark and opposer's mark are identical, i.e., ARIEL. There also is no genuine issue of material fact that applicant's services, as recited in the application, are legally identical to opposer's services. In view of the absence of any limitations or restrictions in applicant's recitation of services, the purported differences in the parties' respective musical styles are immaterial. Likewise, we must presume from the absence of restrictions in applicant's recitation of services that applicant's services are offered in all normal trade channels and to all normal classes of purchasers for such services, including

the trade channels and classes of purchasers in which and to whom opposer offers his legally identical services. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981). There is no evidence of any use by third parties of similar marks for similar services. These *du Pont* factors, as to which there are no genuine issues of material fact, all weigh heavily in favor of a finding of likelihood of confusion in this case.

The only *du Pont* factor which appears to favor applicant is the absence of evidence of actual confusion. However, we cannot conclude that the nature and extent of the parties' respective uses of their marks, to date, have been such that the absence of actual confusion should be accorded any significant weight in our likelihood of confusion analysis. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Certainly, that single factor is insufficient to overcome the numerous other *du Pont* factors which, as discussed above, clearly weigh in favor of a finding of likelihood of confusion.

In summary, we find that there are no genuine issues of material fact as to any of the *du Pont* likelihood of confusion evidentiary factors. Having carefully considered all of the evidence of record as to those factors, we find that a likelihood of confusion exists. Having also found that no genuine issues of material fact exist with respect to opposer's standing and his Section 2(d) priority, we

conclude that opposer is entitled to judgment as a matter of law on his Section 2(d) claim. Therefore, we grant opposer's motion for summary judgment, and deny applicant's cross-motion for summary judgment.

Decision: The opposition is sustained.